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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/088,707	06/02/1998	CHRIS BERTELO	ATOCM67DI	2062

23599 7590 06/28/2002

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EXAMINER

MULLIS, JEFFREY C

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 06/28/2002

22

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-22

Office Action Summary

Application No.

09/088,707

Applicant(s)

BERTELO ET AL.

Examiner

Jeffrey C. Mullis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 and 36-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 36-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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All remaining rejections and/or objections follow.

d Claims 1-34 and 36-48 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Claims 1 and 28 recite a core which may be a polyorganosiloxane rubber but then recite that the core is an alkyl acrylate in "a" but say nothing about the siloxane and furthermore the impact additive in "b" such as shown may be a statistical copolymer of alkyl methacrylate and alkyl acrylate despite the preamble which says that the shell is polymethyl methacrylate. In general it is unclear how the various limitations following the preamble pertain to the polyorganosiloxane rubber recited in the preamble since the claims aside from the preamble refer to the non-polyorganosiloxane component solely.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9-68, 70, 71
Claims 49-70 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wu et al. (USP 5,346,954) or Dunkle (USP 4,659,767), optionally in view of Aoyama et al.

See the Office action of Paper No. 12 at page 4 line 3 et seq.

1-34, 36-48
69, 72 The allowability of claims 1-34 and 36-48 over the prior art is predicated on the assumption that the limitations regarding the covering and shell in claims 1 and 28 also pertain to the polyorganosiloxane rubber. If applicants are merely intending to claim embodiments which require only a thermoplastic polymer in combination with a core/shell impact additive which is unlimited except in that a polyorganosiloxane rubber core is required, the Examiner can take no position on the patentability over the prior art.

Applicants' arguments filed 10-18-01 have been fully considered but they are not deemed to be persuasive.

With regard to claims 1 and 28 and those dependent thereon, these claims are now deemed patentable over the prior art since

applicants' combination of limitations is not taught or suggested by the prior art. It is noted that applicants have argued that since all limitations in the present claims are present in U.S. Patent 5,773,520 that the present claims should be allowed. However, it is the position of the Examiner that merely because similar claims have been allowed in another

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application does not mean that they should be allowable in the present application. With regard to claims 49-70, applicants argue that there is no evidence presented to show the use of diallyl maleate as grafting agent in the core. The Examiner does not agree with this since at the very least, Dunkle et al. at column 4 line 27 specifically discloses the use of diallyl maleate as graft linking monomer.

Any inquiry concerning this communication should be directed to Jeffrey Mullis at telephone number (703) 308-2820.

J. Mullis:cdc

June 24, 2002



Jeffrey Mullis
Primary Examiner
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